

Rejections Under 35 U.S.C. § 103

Claims 1-3, 18, 25, 28, 38, 39, and 43-58 remain rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Janchipraponvej (U.S. Patent No. 4,954,335) in view of Sweger et al. (U.S. Patent No. 5,482,704) and Martino et al. (U.S. Patent No. 6,210,689). Applicants respectfully traverse this rejection for the reasons of record and for the following additional reasons.

In order to establish a prima facie case obviousness, the Office bears the burden of showing that: (1) there is a suggestion or motivation to modify or combine reference teachings, (2) there is a reasonable expectation of success in making such a modification or combination, and (3) the prior art reference, or references when combined, teach or suggest all claim limitations. See MPEP § 2143. Here, the Office has not met this burden, in particular because the Office has failed to establish a suggestion or motivation to combine the teachings of Janchipraponvej with those of Sweger and Martino so as to obtain Applicants' claimed invention.

1. Example II of Sweger Does Not Provide the Requisite Motivation to Substitute CEPA Starch for Polyacrylic Acid Derivatives in the Compositions of Janchipraponvej

According to the Examiner, it would have been obvious to modify the teachings of the cited references by substituting CEPA-Starch, as taught by Sweger into the compositions of Janchipraponvej. Citing Example II of Sweger, the Examiner specifically alleges that, "the conclusions of Sweger that CEPA-starch 'is actually superior to the Carbopol standard' (col. 9, lines 2-3) would have suggested to one of

ordinary skill in the art the desirability of substituting CEPA-starch for Carbopol® as thickeners or emulsion stabilizers in cosmetic compositions for the treatment of skin and hair.” (Office Action, page 4).

Applicants respectfully submit that Example II of Sweger, directed to cosmetic lotion compositions, does not provide the requisite motivation to substitute CEPA-starch for polyacrylic acid derivatives as thickeners in the hair conditioning compositions of Janchipraponvej. The lotion compositions in Example II of Sweger are entirely different than the hair conditioning compositions of Janchipraponvej and Sweger completely fails to identify how CEPA-starch would be expected to perform in compositions other than those disclosed in Example II. In addition, as Applicants have previously noted, Example II is limited to a comparison of samples containing four times as much CEPA-starch as Carbopol®. The example thus fails to provide any teaching or disclosure as to whether CEPA-starch would be superior to Carbopol®, even in its own disclosed compositions, where the ratio of the two components is the same. Accordingly, Applicants respectfully submit that a person having ordinary skill in the art would not be motivated to substitute CEPA-starch for polyacrylic acid derivatives in the compositions of Janchipraponvej based on the disclosure of Example II of Sweger.

2. Combining the Teachings of Janchipraponvej with the Teachings of Sweger by Substituting CEPA Starch for Polyacrylic Acid Derivatives in the Compositions of Janchipraponvej Would Render Those Compositions Unsatisfactory for Their Intended Purpose

Janchipraponvej teaches that his disclosed compositions are “clear hair-treating” compositions. (Janchipraponvej, col. 1, lines 7-8). The reference emphasizes that the

compositions of the invention must be clear and that obtaining such clear compositions requires a delicate balancing of ingredients. For example, the reference states:

Examples 18 through 21 demonstrate the effect of eliminating at least one of the essential ingredients from the composition. In each of Examples 18 through 21, the composition was **opaque and unstable**, separating into distinct aqueous and nonaqueous phases within a short time period.

(Id., col. 20, lines 49-54 (emphasis added)). The reference states that the clear hair-compositions contain five essential ingredients and further states that:

In addition to the five above-described essential ingredients, other common cosmetic components and additives that can be incorporated with the essential ingredients of the present invention, **as long as the basic properties of the hair-treating composition, such as clarity of the composition and an ability to impart hair conditioning properties to hair, are not adversely affected.**

(Id., col. 15, lines 47-54 (emphasis added)). The reference goes on to state that certain thickeners can be suitable in the disclosed conditioning compositions and that these thickeners can include polyacrylic acid derivatives. (Id., col. 16, lines 9-15). No mention is made of modified starches, such as CEPA-starch, for use as thickeners in the disclosed compositions.

Applicants respectfully submit that substitution of CEPA-starch for polyacrylic acid derivatives in the compositions of Janchipraponvej would render those compositions less clear, and hence, unsatisfactory for their intended purpose. Where the “proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

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In the present case, polyacrylic acid derivatives such as Carbopol® are specifically known for their clarity in aqueous solutions and, not surprisingly, are listed as permissible thickeners in the compositions of Janchipraponvej. In contrast, modified starches, such as CEPA-starch are not known for their clarity in aqueous solutions. Instead, starches have been disclosed as imparting increased opacity in cosmetic formulations to which they are added. (See, e.g., U.S. Patent No. 6,475,500 to Vatter et al., col. 12, line 63 to col. 13, line 13 (noting that starches are useful in imparting opacity in cosmetic compositions as pigments)). Accordingly, Applicants submit that a person having ordinary skill in the art would not be motivated to substitute CEPA-starch for polyacrylic acid derivatives into the compositions of Janchipraponvej, which are required to be clear. Therefore, for this additional reason, Applicants respectfully request that the rejection under 35 U.S.C. § 103 be withdrawn.

3. Combining the Teachings of Janchipraponvej with the Teachings of Martino by Adding Alkyl Ether Sulfate Salts as Anionic Surfactants to the Compositions of Janchipraponvej Would Render Those Compositions Unsatisfactory for Their Intended Purpose

The Examiner also asserts that a person of ordinary skill in the art would be motivated to combine alkyl ether sulfate salts as anionic surfactants to the compositions of Janchipraponvej. Applicants respectfully submit that, in view of the teachings of Janchipraponvej, a person of ordinary skill in the art would not be motivated to make such a combination.

As discussed above, the compositions of Janchipraponvej are “clear, homogeneous” conditioning compositions. Nothing in Janchipraponvej teaches or

suggests that anionic surfactants, such as alkyl ether sulfate salts, would be desirable additives to such compositions. To the contrary, the reference states that:

the hair normally is left in a cosmetically -unsatisfactory state after washing with an anionic surfactant-based hair shampoo. Anionic surfactants not only remove the dirt and soil from the hair, but also remove essentially all of the sebum naturally present on the surface of hair fibers. Therefore, it was found that the desirable properties of anionic surfactants that effectively clean the hair also serve to leave the hair in a cosmetically-unsatisfactory condition.

(Janchipraponvej, col. 1, line 61 to col. 2, line 1). The reference then states that conditioning compositions are needed to counteract the effects of anionic surfactant containing shampoo compositions after which it discloses conditioning compositions according to the invention. In view of this disclosure, Applicants respectfully submit that a person having ordinary skill in the art would not be motivated to add anionic surfactants, such as alkyl ether sulfate salts, to the conditioning compositions of Janchipraponvej when the reference expressly teaches that conditioning compositions are useful in overcoming the effects of using anionic surfactants on the hair.

In addition, Applicants note that Janchipraponvej teaches that quaternary ammonium compounds, which are cationic compounds, are essential components of his disclosed compositions. (See *id.*, col. 5, lines 37-43). Cationic compounds are known to have the ability to complex with anionic surfactants, which are foaming surfactants. This complex is water insoluble and the resulting compositions are not clear. Janchipraponvej, however, teaches that his disclosed conditioning compositions must be clear. Accordingly, for this additional reason, Applicants submit that a person of ordinary skill in the art would not be motivated to add anionic surfactants, such as alkyl ether sulfate salts, to the compositions of Janchipraponvej because such addition could

result in a complex, which would render the resulting composition unclear and, hence, unfit for its intended purpose.


For all of the above reasons, Applicants respectfully request that the rejection under 35 U.S.C. § 103 be withdrawn. Applicants further respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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